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In re Application of :  
VAN DYK, Andre : DECISION ON  
US Application No.: 10/500,356 :  
PCT Application No.: PCT/ZA02/00209 : PETITION  
Int. Filing Date: 17 December 2002 :  
Priority Date: 03 January 2002 : UNDER  
Attorney's File Reference: VAND3026/FJD :  
For: ACTIVATED STEMMING DEVICE : 37 CFR 1.47(b)

This decision is in response to applicant's "PETITION UNDER 37 CFR 1.47(b)", filed 22 June 2005, requesting acceptance of the application without the signature the sole inventor Andre Van Dyk (Van Dyk). The \$200 petition fee has been paid.

BACKGROUND

On 17 December 2002, the applicant filed international application number PCT/ZA02/00209 claiming a priority date of 03 January 2002 and listing Van Dyk as the sole inventor. Accordingly, the 30-month time period for entry into the US national stage under 35 USC 371 expired at midnight on 03 July 2004.

On 30 June 2004, applicant filed a transmittal letter concerning a filing under 35 USC 371 along with, inter alia, the basic national fee. No oath or declaration was included.

On 22 November 2004, the US Designated/Elected Office (DO/EO/US) mailed a Notification of Missing Requirements indicating that the applicant was required to provide an oath or declaration within the time period set for response in the notification.

On 22 June 2005, the applicant filed the present "PETITION UNDER 37 CFR 1.47(b)" which is accompanied by, inter alia, 1) a declaration of inventorship signed by Edward Walenty Tota, the general manager of assignee NXCO International Limited, 2) two unsigned letters from the law firm of McCallum Rademeyer and Freimond, dated 02 September 2004 and 20 September 2004, addressed to Van Dyk both indicating that a declaration, power of attorney, and assignment document for the US national stage of international application number PCT/ZA02/00209 were included therewith and requesting that Van Dyk sign and return the enclosed documents, 3) a copy of an email dated 17 December 2004, including twenty-one attachments, from Monty Rademeyer, of the law firm of McCallum Rademeyer and Freimond, to Van Dyk indicating that a copy of the specification, claims, declaration, power of attorney, and

assignment document for some unidentified patent applications were included for his signature, 4) a statement of Roy Francis Taberer (Taberer statement) of the law firm of McCallum, Rademeyer, and Freimond dated 30 May 2005, 5) an unsigned letter from the law firm of McCallum Rademeyer and Freimond, dated 03 May 2005, addressed to Van Dyk indicating that a full copy of the specification including the claims, drawings, and abstract as well as the declaratrin for the US national stage of international application number PCT/ZA02/00209 had been previously sent via email to Van Dyk and requesting that Van Dyk sign and return the declaration, 6) a copy of a postal tracking receipt dated 09 May 2005 and indicating that the status of the package was "First notification to the client to collect the postal item".

### DISCUSSION

A petition under 37 CFR 1.47(b) must be accompanied by (1) the fee under 37 CFR 1.17(g), (2) factual proof that the inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the inventor, (4) an oath or declaration by the 37 CFR 1.47(b) applicant on behalf of and as agent for the non-signing inventor, (5) proof that the 37 CFR 1.47(b) applicant has sufficient proprietary interest in the application, and (6) a showing that such action is necessary to preserve the rights of the parties or to prevent irreparable damage. A review of the application file reveals that petitioner has satisfied items (1), (3), (4), and (5).

With regard to item (2) above, MPEP section 409.03(d) entitled "Proof of Unavailability or Refusal" states, in part:

#### **REFUSAL TO JOIN**

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the nonsigning inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney. . . . It is reasonable to require that the inventor be presented with the application papers before a petition under 37 CFR 1.47 is granted since such a procedure ensures that the inventor is apprised of the application to which the oath or declaration is directed. *In re Gray*, 115 USPQ 80 (Comm'r Pat. 1956).

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Proof that a *bona fide* attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the

statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

It is not clear that Van Dyk was ever presented with a complete copy of the above-identified application including the specification, drawings, and claims as well as an oath or declaration. The letters of 02 September 2004 and 20 September 2004 both only indicate that a declaration, power of attorney, and assignment document were being provided to Van Dyk. There is no indication that a complete copy of the application including the specification, claims, and drawings as well as the declaration were provided to non-signing inventor Van Dyk. In addition, the email dated 17 December 2004 and addressed to Van Dyk indicates that a full copy of the specification, claims, declaration, power of attorney, and assignment document for some patent applications are attached thereto. However, there is no clear indication as to which applications the email pertains. Further, the email includes twenty-one attachments, none of which are clearly labeled as being directed to any particular application. As such, it is unclear as to which applications the email is directed. The letter of 03 May 2005 only indicates that a full copy of the specification, claims, drawings, and declaration were sent to non-signing inventor Van Dyk in a previous email. There is no indication that a complete copy of the application including the specification, claims, and drawings was attached to the letter. Finally, the Taberer statement indicates that a declaration attached to a full copy of the application as filed was sent to non-signing inventor Van Dyk along with the letter of 03 May 2005. However, it does not appear that Taberer has first-hand knowledge of exactly which papers were sent to Van Dyk with the letter of 03 May 2005 since it does not appear that Taberer himself mailed the letter of 03 May 2005.

Accordingly, it is not clear whether non-signing inventor Van Dyk was ever presented with a complete copy of the application papers including the specification, claims, drawings, and oath or declaration. Further, even if Van Dyk was presented with a complete copy of the application papers along with the letter of 03 May 2005, it is not clear that Van Dyk refused to sign the declaration after having reviewed that complete copy of the application. The Taberer statement indicates that as of 30 May 2005 Van Dyk had neither contacted Taberer nor returned the signed declaration to Taberer. However, the postal tracking receipt of 09 May 2005 indicates that the letter of 03 May 2005 only first became available to Van Dyk as of 09 May 2005. It is not clear that Van Dyk would have had time to fully review the letter and respond to Taberer within the three weeks between 09 May 2005, the time the 03 May 2005 letter first became available to him, and 30 May 2005, the date of the Taberer statement. Further, there is no evidence that Van Dyk refused to execute the declaration after having reviewed the complete copy of the application.

Accordingly, the applicant is required to provide either 1) a declaration of inventorship signed by Van Dyk or 2) sufficient factual proof that Van Dyk refuses to execute the application

after having been provided with a complete copy of the application including the description, claims, drawings, and oath or declaration.

With regard to item (6) above, MPEP 409.03(g) states:

Irreparable damage may be established by a showing (a statement) that a filing date is necessary to preserve the rights of the party or to prevent irreparable damage.

The applicant must show that a grant of status under 37 CFR 1.47(b) is necessary to preserve the rights of the parties or to prevent irreparable damage. Irreparable damage may be established by simply providing a statement in accordance with MPEP 409.03(g) indicating that a filing date is necessary to preserve the rights of the party or to prevent irreparable damage.

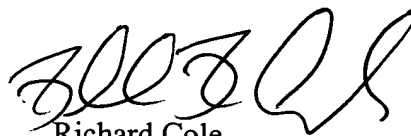
### CONCLUSION

For the above reasons, applicants' petition under 37 CFR 1.47(b) is **DISMISSED**, without prejudice.

If reconsideration on the merits of this petition is desired, a proper response must be filed within TWO (2) MONTHS from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(b)." No additional petition fee is required. Extensions of time may be obtained under 37 CFR 1.136(a). Failure to timely file a proper response to this decision will result in ABANDONMENT of the application.

Any further correspondence with respect to this matter deposited with the United States Postal Service should be addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

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